UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,423	12/28/2000	Ralf Rick	10191/1665	7857

26646　　　7590　　　05/13/2004	EXAMINER	
KENYON & KENYON	CHEN, SHIN HON	
ONE BROADWAY	ART UNIT	PAPER NUMBER
NEW YORK, NY 10004	2131	

DATE MAILED: 05/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _13 April 2001_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) _____ is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-8_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _28 December 2000_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☒ All b)☐ Some * c)☐ None of:

　　　　1.☒ Certified copies of the priority documents have been received.

　　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
　　　　application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _4_.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1.   Claims 1-8 have been examined.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an
> international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
> subsection of an application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

3.   Claims 1, 4, 5, and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Larsson

et al. U.S. Pat. No. 6226747 (hereinafter Larsson)

4.   As per claims 1, Larsson discloses a device for preventing pirated copies of computer

programs for use with a computer (Larsson: column 3 line 42 – column 4 line 38), comprising:

input and output device for bi-directional data exchange with the computer (Larsson: column 3

line 42 – column 4 line 38); a first memory element containing a data file that is transferable to

the computer via the output device (Larsson: column 5 lines 4-8: compare the data stored in the

floppy disk with information stored on CD); and a second memory element into which data is

writable by the input device (Larsson: column 9 lines 19-35: records computer identification

information).

5.   As per claim 4, Larsson discloses the device according to claim 1. Larsson further

discloses wherein the input and output devices are adapted to a module port of the computer so

that the input and output devices are insertable into the module port (Larsson: column 3 line 42 –

column 4 line 37: inserting the floppy disk). Floppy disk provides input/output function and uses

input/output port of a computer to read/write data to a computer.

6.   As per claim 5, Larsson discloses a method of preventing pirated copies of computer

programs (Larsson: column 3 line 42 – column 4 line 38), comprising the steps of: connecting a

device to a computer for bi-directional data exchange (Larsson: column 3 line 42 – column 4 line

38), the device including input and output devices and first and second memory elements

(Larsson: column 5 lines 4-8 and column 8 lines 20-31: reading license information for

verification; column 9 lines 19-34: writing computer identification information to memory);

transferring a first data file containing a key from the first memory element of the device to the

computer (Larsson: column 8 lines 20-49); and copying a second data file containing an

identifier from the computer to the second memory element of the device (Larsson: column 9

lines 19-33).

7.   As per claim 8, Larsson discloses a data carrier storing a computer program (Larsson:

column 3 line 42 – column 4 line 38), the computer program being executable by entering the

data carrier into a computer (Larsson: column 3 line 42 – column 4 line 38), the data carrier

containing a key and an identifier (Larsson: column 8 lines 20-49 and column 9 lines 5-33), the

computer program, upon execution, carrying out the following steps: transferring a first data file

containing the key from a first memory element of a device to the computer (Larsson: column 5

lines 4-8 and column 8 lines 20-49), the device further including input and output devices

(Larsson: column 8 lines 20-49 and column 9 lines 5-33); and copying a second data file

containing the identifier from the computer to a second memory element of the device (Larsson:

column 9 lines 5-33).

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

9.   Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larsson in

view of Pavlin et al. U.S. Pat. No. 6523119 (hereinafter Pavlin).

10.   As per claim 2, Larsson discloses the device according to claim 1. Larsson does not

explicitly disclose wherein the first and second memory elements are integrated into a memory

chip. However, Pavlin discloses dongle/hardware key includes memory chip (Pavlin: column 4

line 66 – column 5 line 15). It is well known in the art to include memory chips in

dongle/hardware keys which are used to protect software from illicitly used. Pavlin reference

discloses read only memory chips such as EEPROM. However, it would have been obvious to

one having ordinary skill in the art to change the memory chip disclosed by Pavlin to read/write

memory chip to allow dynamic read/write function as supported by floppy disks and the floppy

disk information disclosed by Larsson is stored in read-only area while the computer

identification information is to be inputted into writable area of a memory chip. Therefore, it

would have been obvious to one having ordinary skill in the art to combine the teachings of

Pavlin within the system of Larsson because it is well known in the art to use different types of

memory to perform security processes and it does not reduce the performance of the system.

Alternatively, Larsson also discloses that other types of memory can be implemented (Larsson:

column 5 lines 23-28).

11.   As per claim 3, Larsson as modified discloses the device according to claim 2. Larsson as

modified further discloses wherein the memory chip is a nonvolatile semiconductor memory

(Pavlin: column 4 line 66 – column 5 line 15). Same rationale applies here as above in rejecting

claim 2.

12.   Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Larsson in Kupka

U.S. Pat. No.6434535 (hereinafter Kupka) and further in view of Mullor et al. U.S. Pat. No.

6411941 (hereinafter Mullor).

13.   As per claim 6, Larsson discloses the method according to claim 5. Larsson does not

explicitly disclose the method further comprising the step of entering into the computer an enable

number encoded with the key. However, Kupka further discloses entering license information

into the computer for verification (Kupka: column 1 lines 35-57). It would have been obvious to

one having ordinary skill in the art to prompt users to enter license information for comparison is

well known in the art. Therefore, it would have been obvious to one having ordinary skill in the

art to combine the teachings of Kupka within the system of Larsson.

Larsson as modified does not explicitly disclose entering encoded enable number encoded by

key stored in the memory. However, Mullor discloses comparing decrypted license information

stored in the computer (Mullor column 6 lines 28-39). It would have been obvious to one having

ordinary skill in the art to modify the Larsson reference to store key for decrypting encrypted

license information, which is well known in the art, and modify the Kupka reference by entering

encrypted license information that can be decrypted using the key provided in the memory and

then compare the result. Therefore, it would have been an obvious matter of design choice to

modify the references to enter encrypted license information into computer and decrypt it using

key stored in memory device since the applicant does not explicitly disclose entering encrypted

license information and then decrypt it using key stored in the memory solves any stated problem

or is for any particular purpose and it appears that comparing license information stored in the

memory with the license information stored in the software would perform equally well for

verification.

14.   Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Larsson.

15.   As per claim 7, Larsson discloses the method according to claim 5. Larsson does not

explicitly disclose the step of transferring the key from the computer back to the connected

device after checking the identifier. However, Larsson discloses uninstalling/removing the

software from the computer in order to install on another computer and removing the computer

identification from the file (Larsson: column 10 line 36 – column 11 lines 29). It would have

been an obvious matter of design choice to modify the Larsson reference to transfer the key back

from the computer back to the connected device after checking the identifier since the applicant

does not disclose transferring the key back solves any stated problem or is for any particular

purpose and it appears that uninstalling the software from the computer would perform equally

well.

Conclusion

16.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

Benson U.S. Pat. No. 6334118 discloses using dongle or hardware key to keep track of

rented software by storing usage information in the dongle (column 1 lines 42-64).

Ahmad U.S. Pat. No. 5925127 discloses method and system for monitoring the use of

rented software.

Abdulhayoglu PCT No. WO9406071 discloses a dongle in form of a floppy disk.

Takenaka et al. U.S. Pat. No. 5917908 discloses purchasing license key to decrypt the

protected software (column 1 line 22 – column 3 line 53).

Mu et. al. U.S. Pat. No. 5343524 discloses intelligent security device.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Shin-Hon Chen whose telephone number is (703) 305-8654. The

examiner can normally be reached on Monday through Friday 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ayaz Sheikh can be reached on (703) 305-9648. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shin-Hon Chen
Examiner
Art Unit 2131

SC

AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100